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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,434	04/05/2004	Teruaki Nagai	40424-200783	1289

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VENABLE LLP
P.O. BOX 34385
WASHINGTON, DC 20043-9998

EXAMINER

NICHOLSON III, LESLIE AUGUST

ART UNIT PAPER NUMBER

3651

DATE MAILED: 10/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/817,434	Applicant(s) NAGAI, TERUAKI	
	Examiner Leslie A. Nicholson III	Art Unit 3651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-13, 19 is/are rejected.
- 7) ☒ Claim(s) 14-18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/4/2006 have been fully considered but they are not persuasive.

Applicant argues Osaka fails to disclose "a method where a printed product is wire-stitched along the outside folded edge so that the preformed wires point toward the inside folded edge and then, the outside folded edge is covered with a protective signature page", "the gluing step of claim 1", and "the circulating intermediate conveyor". In response, the Examiner disagrees. Osaka discloses the method of the printed product wire-stitched along the outside folded edge so that the preformed wires point toward the inside folded edge, as performed by element 114a (see C4/L63-66 and C9/L15-20). Secondly, saddle-stitched books 'a' and 'b' contain printed signatures which includes an outside signature. Because 'a' and 'b' are glued together, the outside folded edge of book 'b' is glued to the inside folded edge of the inside signature with the printed product. Finally, Osaka discloses a circulating intermediate conveyor (124a) (see fig.8,9).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3,5-6,8-13,19 are rejected under 35 U.S.C. 102(b) as being anticipated by Osako USP 5,678,813.

Osako discloses a method for producing a print article that includes

- transporting the printed product (b'), in an open state, on a saddle-shaped conveying section (111) of a conveying track (111, 117, 129), the printed product straddling the conveying section (see Fig. 9, B)
- wire-stitching (114) the printed product along the outside folded edge thereof so that pre-formed wire sections point toward the inside folded edge
- transporting the printed product (b') in a closed state (at 124a) and reopening the printed product (see Fig. 9, when fed from feeder 124)
- gluing (123) the outside folded edge of a protective signature (a') to the inside folded edge of the printed product to form a combined article (c') on an additional conveying section (117) of the conveying track (111, 117, 129)
- feeding a cover sheet (101), to the outside folded edge of the combined article (c'), applied with adhesive (131a), on an additional conveying section (129) of the conveying track (111, 117, 129).

Osako also discloses an apparatus for producing a print article that includes:

- a first conveying section of a conveying track having a saddle shaped support (See Fig. 9, 111)
- a wire-stitching section (114)

- a second conveying section of conveying track having a saddle shaped support (117)
- a circulating intermediate conveyor (124a) positioned near the end of the first conveyor and in alignment with the second conveying section
- an adhesive applicator (123) positioned in an extension region of the second conveying section (117), upstream of a delivery region (124)
- a fold feeder (118) to feed a protective signature onto the extension region of the second conveying section (117)

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Osako USP 5,678,813 in view of Axelrod USP 4,420,282.

Osako discloses all the limitations of the claim, but it does not disclose the step of applying an adhesive to the inside folded edge of the cover sheet to attach the cover sheet to the combined article. Rather, Osako discloses the step of applying an adhesive the outside folded edge of the combined article to attach the cover sheet to the combined article (see Fig. 9).

However, Axelrod discloses a similar method that includes applying an adhesive (see col. 2, lines 65-70) to the inside folded edge of a cover sheet (20) to attach the cover sheet to a combined article (10) in addition to applying an adhesive (31) the outside folded edge of the combined article to attach the cover sheet to the combined article for the purpose of producing a book that has a substantially stronger backing that resists being broken apart far more successfully than books produced by merely applying an adhesive the outside folded edge of the combined article (see col. 1, lines 60-64).

It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Osako by applying an adhesive to the inside folded edge of a cover sheet to attach the cover sheet to a combined article in addition to applying an adhesive the outside folded edge of the combined article to attach the cover sheet to the combined article, as disclosed by Axelrod, for the purpose of producing a book that has a substantially stronger backing that resists being broken apart far more successfully than books produced by merely applying an adhesive the outside folded edge of the combined article.

Allowable Subject Matter

6. Claims 14-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

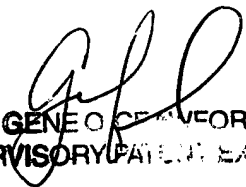
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie A. Nicholson III whose telephone number is 571-272-5487. The examiner can normally be reached on M-F, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on 571-272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

L.N.
10/20/2006


GENE O. CRAWFORD
SUPERVISORY PATENT EXAMINER